

### **REMARKS**

Claims 1-41 and 43-49 are presently pending. Claim 42 has been canceled. Claims 1 and 47 have been amended. Claim 49 has been added. The specification has been amended to shorten the abstract of the disclosure and to include Tables 1-3 as figures.

Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the remarks appearing below.

#### **Objection to the Specification**

The Examiner has objected to the specification, indicating that the abstract exceeds 150 words and improperly contains an implied phrase.

Applicants have amended the abstract so that the word count falls within the 150 word limit and to exclude the implied phrase. Accordingly, Applicants respectfully request that the Examiner withdraw the present objection.

#### **Draftsperson's Objections to the Drawings**

The draftsperson objected to the drawings filed on November 28, 2000 stating that Tables 1-3 must be numbered as drawings, and that borders on all drawings must be removed. Applicants have revised the drawings accordingly. Corrected drawings are attached hereto, and have also been submitted to the draftsperson directly. In this connection, Applicants have amended the specification to include Tables 1-3 as figures.

#### **Rejections under 35 U.S.C. § 112, Second Paragraph**

The Examiner has rejected claim 42 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as their invention. In particular, the Examiner states that claim 42 contains a trademark as a claim limitation and that use of a trademark as a claim limitation is not permitted because trademarks are source identifiers, not the goods themselves.

Applicants have canceled claim 42. Therefore, the present rejection is moot. Consequently, Applicants respectfully request that the Examiner withdraw this rejection.

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**Rejections under 35 U.S.C. § 103*****The Brady et al./Rivette et al. combination***

The Examiner has rejected claims 1-8, 10-12, 43, 45, 47 and 48 under 35 U.S.C. § 103 as being obvious in view of U.S. Patent No. 6,463,430 to Brady et al. and U.S. Patent No. 9,499,026 to Rivette et al., stating Brady et al. disclose a method and system containing all of the elements of these claims except for certain features, e.g., entering data values into fields and use of a second database. The Examiner then asserts that Rivette et al. disclose these features and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Rivette et al. in the method and system disclosed by Brady et al. Applicants respectfully disagree.

Brady et al. disclose methods for generating and managing a database. The method includes, among other steps, retrieving documents from a network of documents using mining or crawler software, harvesting information from specific fields of the document using harvesting software, classifying the harvested information according to a desired taxonomy using taxonomy software and storing the classified and harvested information in a database. Once the database is generated, a user can search the database so as to determine the most relevant documents relative to a particular search query. Using the search results, the user can link to the document(s) of interest. The database can be updated (maintained) by periodically repeating the automatic mining, harvesting, classifying and storing steps to store information relating to documents posted to the network since the last update and remove information relating to documents no longer posted.

Rivette et al. disclose a system and method for processing information from, and relating to, patents. The system maintains patent databases (col. 18, lines 23 et seq.) containing patent documents, and other databases, e.g., document databases (col. 18, lines 23 et seq.) containing non-patent documents, patent bibliographic databases (col. 19, lines 8-53), document bibliographic databases (col. 19, lines 1-7) and group databases (col. 20, line 39 to col. 22, line 27), among others. Group databases generally contain a data structure for each group that lists patents relating to that group. The system further includes analysis modules (col. 36, lines 19-54) for processing patent information of patent databases and other information in other

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databases. These databases and the analysis modules, among other components of the system, reside on an enterprise server. One or more clients communicate with the enterprise server and allow corresponding users to use the system for analyzing the "patent-centric" information stored on the enterprise server in the databases discussed above.

Generally, the Rivette et al. system and method appear to work as follows. At least one group is identified and stored in the group database. Again, each group generally comprises a list of patents stored in the patent databases and, optionally, other documents stored in other databases of the system. The group may be automatically compiled by the system or may optionally be compiled by a user via a client, e.g., using search tools for searching the various databases of the system.

Once a group has been established, the same or another user may initiate via a client one of the various analysis modules, each of which operates on the relevant databases of the system and sends the results of the analysis to the client. The client includes modules corresponding to each of the analysis modules on the enterprise server. These client-side modules allow the user to configure the results sent by the enterprise server in the manner most desired by the user. The system also includes an exporting patent data module, which allows a user to download portions of the system databases, e.g., particular patents from the patent database, to any location the user specifies.

Regarding independent claim 1, this claim, as amended, requires, among other things, that certain steps be performed in certain sequences relative to other steps and that particular information be stored in a second database prior to the last recited step of analyzing the information contained in the second database as a result of the preceding steps. Neither Brady et al. nor Rivette et al. disclose or suggests, alone or in combination with one another, these features of amended claim 1. Furthermore, someone skilled in the art would not arrive at the subject matter of amended claim 1 with knowledge gained from the Brady et al. and Rivette et al. patents, knowledge common in the art or knowledge gained from any other reference of record.

Applicants agree that many of the steps of amended claim 1, when considered in isolation from one another and outside the sequence recited in this claim, are disclosed by Brady et al. and Rivette et al. However, it is not proper to do this. Rather, that certain steps depend upon certain

other steps and that the steps are sequenced are important and must be considered in rejecting claim 1.

In addition, Brady et al. and Rivette et al. do not disclose or suggest, alone or together, the step of analyzing information in a second database, wherein that information is the particular information provided to the second database in previous steps of claim 1. This is so because neither Brady et al. nor Rivette et al. disclose or suggest entering into a second database: 1) at least one document; 2) values of a first set of fields; 3) a second set of fields; and 4) information from reading the at least one first document pertaining to the second set of fields. Again, it could be asserted that one or the other of the Brady et al. and Rivette et al. patents disclose entering such information into separate databases. However, there is nothing in these patents that discloses or suggests putting all of this information into a common database.

For example, the Brady et al. method does not enter any documents into a database. (Nor are the documents in the Brady et al. method stored in a first database. They are stored in many databases across a network.) The Brady et al. system merely mines information from documents and stores the mined information in a database. A document may then be retrieved by linking to the desired document via the mined information. In addition, Brady et al. do not disclose entering values for a first set of fields under which the documents in the first database are organized.

The Rivette et al. patent similarly does not disclose entering all of the information of amended claim 1 into a second database. While Rivette et al. disclose various modules that a user can use to store portions of the databases anywhere the user desires, Rivette et al. do not disclose or suggest entering a number of portions, and particularly 1) at least one document, 2) values of a first set of fields, 3) a second set of fields and 4) information from reading the at least one first document pertaining to the second set of fields, into a second database as amended claim 1 requires. It is Applicants' position that any such assertion could be made only in hindsight of the present claims. This sort of hindsight in formulating an obviousness rejection is improper.

Rivette et al. also do not disclose or suggest analyzing all such information from a second database. This is so because the Rivette et al. analysis modules utilize any number of the

discrete databases mentioned above. While the Rivette et al. system and method may have the functionality that allows a user to export information from the various databases, the analysis modules do not operate on such exported information, regardless of whether or not the information is in a second database. Of course, as discussed above, there is not even a suggestion by Rivette et al. to export the disparate information required by amended claim 1 to a second database. The exported information is exported for other reasons.

In view of the foregoing, Applicants assert that claim 1, as amended, is not obvious in view of a combination of the Brady et al. and Rivette et al. patents.

Regarding dependent claims 2-8, 10-12, 43 and 45, these claims are patentable for at least the reason that they depend from amended independent claim 1, which is patentable over the cited references for the reasons discussed above.

Regarding independent claim 47, this claim, as amended, has a number of limitations that are not disclosed or suggested by Brady et al. and Rivette et al., either alone, in combination with one another and/or in combination with other references of record or ordinary skill in the art. For example, amended claim 47 requires, among other things, computer instructions for entering 1) at least one document, 2) values of a first set of fields, 3) a second set of fields and 4) information from reading the at least one first document pertaining to the second set of fields. As discussed above relative to amended claim 1, neither Brady et al. nor Rivette et al. disclose or suggest entering such information into a second database. Likewise, neither Brady et al. nor Rivette et al. disclose or suggest computer instructions operatively configured to analyze the disparate information contained in the second database for the reasons discussed above relative to amended claim 1. Therefore, Applicants assert that claim 47, as amended, is not obvious in view of a combination of the Brady et al. and Rivette et al. patents.

Regarding dependent claim 48, this claim is patentable for at least the reason that it depends from amended independent claim 47, which is patentable over the cited references for the reasons just discussed.

***The Brady et al./Rivette et al./Takahashi et al. combination***

The Examiner has rejected claim 9 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent

No. 6,424,429 to Takahashi et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of claim 9 except for the first database being a Japanese Patent Office (JPO) database. The Examiner then asserts that Takahashi et al. disclose a JPO database and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the JPO database with the method allegedly disclosed by Brady et al. and Rivette et al. Applicants respectfully disagree.

Claim 9 is patentable for at least the reason that it depends from amended independent claim 1, which is patentable for the reasons discussed above in connection with the obviousness-type rejection in view of the Brady et al. and Rivette et al. patents.

***The Brady et al./Rivette et al./Amro et al. combination***

The Examiner has rejected claims 13-15 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,041,326 to Amro et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of these claims except for the documents being books, newspapers and magazines. The Examiner then asserts that Amro et al. disclose books, newspapers and magazines and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the method allegedly disclosed by Brady et al. and Rivette et al. in connection with books, newspapers and magazines. Applicants respectfully disagree.

Claims 13-15 are patentable for at least the reason that each depends from amended independent claim 1, which is patentable for the reasons discussed above in connection with the obviousness-type rejection in view of the Brady et al. and Rivette et al. patents.

***The Brady et al./Rivette et al./Reed et al. combination***

The Examiner has rejected claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,088,717 to Reed et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of these claims except for certain features, e.g., developing

answers to questions contained in a first input form. The Examiner then asserts that Reed et al. disclose these features and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Reed et al. in the method allegedly disclosed by Brady et al. and Rivette et al. Applicants respectfully disagree.

Reed et al. disclose a system for automatically notifying and providing updated information to an information consumer whenever an information provider having a predetermined relationship with the information consumer provides new information and/or changes existing information previously provided to the information consumer, and the information consumer desires to receive the updated information. To implement these automated features, the Reed et al. system requires a consumer program (22) and a provider program (12) that communicate with one another, each running on a corresponding computer.

Regarding forms, Reed et al. disclose the use of forms (see, e.g., FIG. 27 for an example of the Reed et al. forms) in the context of technical support by a software provider to a software consumer. On the consumer side, the consumer fills out a form that requests information relating to the consumer, e.g., name, and to the problematic software, e.g., the system on which the software is used. The form also has a field for the consumer to ask the software provider a question regarding the problem or provide further details of the problem the consumer is experiencing with the software. On the provider side, the software provider can call up a similar form for addressing the consumer's problem.

In contrast, the present invention is directed to a method and system for analyzing one or more documents and other information extracted from and/or relating to the one or more documents. One part of the method is to retrieve and read at least one document to retrieve information pertaining to a second set of fields. In one embodiment, the second set of fields are user-defined fields developed from answers to questions contained in a first input form. This is the subject matter of dependent claim 16, which depends directly from amended independent claim 1.

In addition to claim 16 being patentable over the references of record by virtue of its dependence upon amended claim 1, which is patentable for the reasons discussed above,

claim 16 is also patentable due to its own subject matter. That is, Applicants believe that, although Reed et al. disclose the use of forms in one context, i.e., on-line technical support for software, the Reed et al. disclosure does not render obvious the use of forms in claim 16, which is directed to a completely different context. It cannot fairly be said that the Reed et al. two-way communication use of forms render obvious the first forms of claim 16 that are used for developing a second set of user-defined fields that are subsequently entered into a second database and thereafter analyzed (see amended claim 1). In addition, neither Brady et al. nor Rivette et al. provide any suggestion to make the combination with the Reed et al. patent, nor would anyone skilled in the art be motivated to make the combination, at least without hindsight of the present claims.

In view of the foregoing, Applicants respectfully assert that the cited combination of the Brady et al., Rivette et al. and Reed et al. patents do not render dependent claim 16, nor claims 18-26, 28, 30-34, 36, 40 and 41 that depend therefrom, obvious. In addition, Applicants believe claims 18-26, 28, 30-34, 36, 40 and 41 contain subject matter that is separately not obvious in view of the combination. However, Applicants defer arguing the rejection of these claims because of the clear patentability of claim 16, but reserve the right to do so if the need arises in a future Office Action.

Regarding dependent claim 46, this claim requires the additional step of developing a high level of abstraction view of a plurality of documents. Reed et al. simply do not disclose or suggest such a step. Reed et al. do use the term "abstraction." However, they use this term to describe the object-oriented architecture of their system. This has nothing whatsoever to do with developing a high level of abstraction view of a plurality of documents. Therefore, Applicants assert that the Examiner made the present rejection in hindsight of claim 46 and that claim 46 is not obvious in view of the asserted combination.

***Other claims dependent upon patentable claim 16***

The Examiner has rejected claims 17, 27, 29, 35 and 37-39 under 35 U.S.C. § 103 in view of respective combinations of the Brady et al./Rivette et al./Reed et al. trio with each of U.S. Patent No. 6,438,590 to Gartner et al., U.S. Patent No. 6,311,176 to Steiner, U.S. Patent No. 5,765,138 to Aycock et al., U.S. 5,855,008 to Goldhaber et al., U.S. Patent No. 5,835,758 to



Nochur et al. and U.S. Patent No. 5,400,086 to Sano et al. Each of these claims depends from claim 16, which is patentable over the references of record for the reasons discussed above in connection with the rejection of claim 16. In addition, Applicants believe claims 17, 27, 29, 35 and 37-39 contain subject matter that is separately not obvious in view of the combination. However, Applicants defer arguing the rejection of these claims because the clear patentability of claim 16, but reserve the right to do so if the need arises in a future Office Action.

***The Brady et al./Rivette et al./Sneeringer combination***

The Examiner has rejected claim 42 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above in connection with the rejection of claim 1, above, and further in view of U.S. Patent No. 6,618,709 to Sneeringer. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of this claim except for a Microsoft Access® database. The Examiner then asserts that Sneeringer discloses a Microsoft Access® database and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the Microsoft Access® database in the method allegedly disclosed by Brady et al. and Rivette et al.

Applicants have canceled claim 42. Therefore, the present rejection is moot.

***The Brady et al./Rivette et al./Kableshkov combination***

The Examiner has rejected claim 44 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,108,663 to Kableshkov. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of claim 44 except for the step of summing values in a second set of fields. The Examiner then asserts that Kableshkov discloses this summation step and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the summation step disclosed by Kableshkov in the method allegedly disclosed by Brady et al. and Rivette et al. Applicants respectfully disagree.

In making the present rejection, the Examiner states that Brady et al. disclose a second set of fields, Rivette et al. teach the elements of "is associated with a value" and analyzing, and

Kableskov teaches summing values and then asserts that claim 44, which requires summing values associated with a second set of fields, is obvious. Applicants assert that the Examiner is taking the limitation of claim 44 out of its proper context relative to amended independent claim 1 from which claim 44 depends. In its proper context, claim 44 requires not only the summation of values associated with a second set of fields, but rather values that are extracted from reading at least one document retrieved from a first database and stored in a second database, along with the value associated with the second set of fields. None of the Brady et al., Rivette et al. and Kableskov patents, alone, in combination with one another or in combination with any references of record or ordinary skill in the art, disclose or suggest all of the features of claim 44 as it depends from claim 1. Accordingly, Applicants assert that the cited combination has been made in hindsight of claim 44 and does not render claim 44 obvious.

***The Brady et al./Rivette et al./Blakely et al. combination***

The Examiner has rejected claim 46 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 5,761,493 to Blakely et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of these claims except for the step of developing a high level of abstraction view. The Examiner then asserts that Blakely et al. disclose developing a high level of abstraction view and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize this step disclosed by Blakely et al. in the method allegedly disclosed by Brady et al. and Rivette et al. Applicants respectfully disagree.

Like the Reed et al. patent discussed above relative to the rejection of claim 46, the Blakely et al. patent includes the term "abstraction" in the context of describing object-oriented data structures. However, claim 46 requires the step of developing a high level of abstraction view of a plurality of documents. Blakely et al. simply do not disclose or suggest such a step. The use of the term "abstraction" by Blakely et al. has nothing whatsoever to do with developing a high level of abstraction view of a plurality of documents. Therefore, Applicants asserts that the Examiner made the present rejection in hindsight of claim 46 and that claim 46 is not obvious in view of the asserted combination.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw all of the rejections made under 35 U.S.C. § 103.

**New Claim 49**

New claim 49 is a structure claim directed to a computer readable storage medium containing a computer program for performing the method of amended claim 1. Accordingly, Applicants assert that claim 49 is patentable for essentially the same reasons that amended claim 1 is patentable.

**Conclusion**

In view of the foregoing, Applicants respectfully submit that claims 1-41 and 43-49, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

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